

TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

APR Network, Inc.,

Petitioner

v.

Jupitermedia Corporation,

Registrant.

Cancellation No. 92043766

Registration No. 2,514,183

Date of Issue: December 4, 2001

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**REPLY TO PETITIONER'S OPPOSITION TO
REGISTRANT'S MOTION TO SUSPEND CANCELLATION PROCEEDING**

PROCEDURAL HISTORY

On September 13, 2004, APR Networks, Inc. ("Petitioner"), as plaintiff, commenced a declaratory judgment action against Jupitermedia ("Respondent"), as defendant, in the United States District Court for the Central District of California, Case No. CV04-7578 (the "Civil Action") alleging that Petitioner has not violated any trademark or other intellectual property rights of Jupitermedia in and to its registered trademark SEARCH ENGINE STRATEGIES (the "Mark") in continuing to use the domain name <searchenginestrategies.biz> (the "Domain Name"). On or about October 18, 2004, Jupitermedia filed an Answer and Counterclaims in the Civil Action, alleging, *inter alia*, claims for trademark infringement, unfair competition and violation of the Anti-Cybersquatting Act.



12-21-2004

On or about September 15, 2004, Petitioner filed a petition to cancel the Mark in the instant proceeding (the "Cancellation Proceeding") before the Trademark Trial and Appeal Board ("TTAB" or "Board"). On November 18, 2004, Jupitermedia filed a Motion to Suspend the Cancellation Proceeding and Memorandum In Support (the "Motion to Suspend") confirming that the Civil Action was active and pending.

On or about December 7, 2004, Petitioner filed a Motion in Opposition to Respondent's Motion to Suspend ("Opposition to Motion to Suspend") in the TTAB. On December 8, 2004, the Board issued an Order granting Jupitermedia's Motion to Suspend the Cancellation Proceeding. Jupitermedia hereby submits to the Board its Reply to Petitioner's Opposition to Motion to Suspend, requesting the Board to affirm its initial Order granting Respondent's Motion to Suspend.

ARGUMENT

Petitioner is engaging in forum shopping. Forum shopping is a "practice strongly discouraged" by the courts. *Beverly v. Network Solutions, Inc.*, 49 U.S.P.Q.2d 1567, 1575 (N.D. Cal. 1998). Petitioner chose to first file the Civil Action in the Central District of California and then subsequently filed this Cancellation Proceeding. If Petitioner was truly after the Board's singular decision to cancel Jupitermedia's registration, Petitioner could have simply filed a cancellation action. Instead, Petitioner chose to file suit first in California where it does business. It was not until after Jupitermedia filed its Answer and Counterclaims in the Civil Action that Petitioner decided the TTAB would be a preferable forum to the Central District of California. Once Petitioner realized that it would be subject to counterclaims of trademark infringement, unfair competition and violation of the Audit-Cybersquatting Act, relief not available to Jupitermedia before the TTAB, Petitioner scrambled to try to stay the Civil Action

that it brought and oppose Jupitermedia's Motion to Suspend before the TTAB.¹ Petitioner is using forum shopping as a way to extricate itself from the Civil Action and avoid liability and possible damages, something Petitioner should have considered prior to filing both actions.

Petitioner cannot have it both ways. As the Second Circuit pointed out in *Goya Foods, Inc. v. Tropicana Products, Inc.*, 846 F.2d 848 (2nd Cir. 1988). "where...a district court suit concerns infringement, the interest in prompt adjudication far outweighs the value of having the views of the PTO...[a litigant] ...it is entitled to have the infringement issue resolved promptly..." *Id.* at 853-854. Further, "a disappointed party from a TTAB proceeding may bring a civil action in a United States District Court, and then receive trial de novo of the very same issue...(as) the record in the PTO is admissible but not binding on the district court." *E&J Gallo Winery v. F.& P. S.p.A.*, 899 F. Supp. 465, 468 (E.D. Cal. 1994)(citing *Goya Foods*, 846 F.2d at 852-853).

Therefore, the Board should reaffirm its decision to suspend the Cancellation Proceeding pending the outcome of the Civil Action, which is still pending and has not been stayed by the District Court.

¹ Jupitermedia's counsel in the Civil Action has proposed in a December 14, 2004 letter to APR's counsel that APR withdraw its Motion to Stay the Civil Action pending the final ruling by the Board on Jupitermedia's Motion to Suspend, or simply withdraw its lawsuit if APR does not wish to pursue the litigation it initiated, which APR has declined to do. Attached as Exhibit A is a true and correct copy of the December 14, 2004 letter from John Rawls of Fulbright & Jaworski LLP to Steele Gillaspey of Gillaspey & Gillaspey.

CONCLUSION

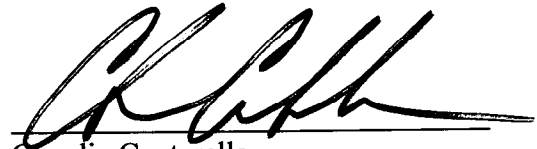
The Board has already ruled to stay the Cancellation Proceeding. For the reasons contained herein and in Respondent's Motion to Suspend, Jupitermedia respectfully requests the that the Board: (a) reaffirm and "So Order" its initial decision to suspend the Cancellation Proceeding pending the outcome of the Civil Action; and (b) order such other and further relief as it deems just and proper.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: December 22, 2004

By:



Claudia Cantarella
Emily L. Schonbraun
Attorneys for Registrant

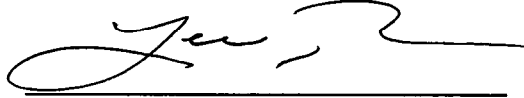
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CERTIFICATE OF MAILING BY EXPRESS MAIL

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I, Lee Thayer, hereby certify that this REPLY TO PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO SUSPEND CANCELLATION PROCEEDING is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service addressed to "BOX TTAB, NO FEE, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451," on December 22, 2004.

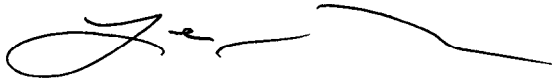


Lee Thayer

CERTIFICATE OF SERVICE

I, Lee Thayer, hereby certify that I have this 22nd day of December, 2004, mailed by first-class United States mail, postage prepaid, the foregoing REPLY TO PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO SUSPEND CANCELLATION PROCEEDING to the following:

Dana B. Robinson, Esq.
3803 Mission Blvd., Suite 100
San Diego, CA 92019



Lee Thayer

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December 14, 2004

VIA FACSIMILE AND U.S. MAIL

Steele N. Gillaspey, Esq.
Gillaspey & Gillaspey
225 Broadway, Suite 2220
San Diego, California

Re: *APR Network Inc. ("APR") v. Jupitermedia Corporation ("Jupitermedia")*,
Central District of California Case NO. CV 04-7578-DSF(RNBx)

Dear Mr. Gillaspey:

We were very surprised to receive APR's Notice of Motion and Motion to Stay the above-referenced matter. It is unusual, to say the least, for a party to seek to stay its own lawsuit. Moreover, APR has ignored Local Rule 7-3, which explicitly requires that "counsel contemplating the filing of any motion shall first contact opposing counsel to discuss thoroughly, *preferably in person*, the substance of the contemplated motion and any potential resolution [T]he conference shall take place at least twenty (20) days prior to the filing of the motion" (emphasis in original). You had ample opportunity to so meet and confer during the Rule 26 teleconference we conducted on November 30, 2004. During that call, you failed even to mention your plans to file a Motion to Stay the very next day, December 1.

We take this opportunity to attempt to meet and confer on your motion now. First, we believe your motion is now moot; the TTAB has stayed the Opposition proceedings pending before it (a copy of the TTAB's order is enclosed for your reference) and we believe that stay will remain in effect despite your client's pending opposition to it. Thus, we believe that your motion should simply be withdrawn, at least until the TTAB has made its final ruling on the stay. Alternatively, if APR does not wish to pursue the litigation that it initiated, we propose that the parties stipulate to dismiss their respective claims without prejudice. In the event you choose not to accept either of the proposals set forth above, Jupitermedia will oppose your motion and will seek sanctions.

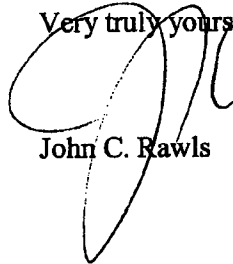
In the event you do not agree to either of the options set forth above, this will confirm your agreement, reached during a December 7, 2004 telephone conference with my colleague, Sarah Silbert, to continue the hearing on your motion to February 7, 2005, and to confirm your agreement in writing. As of today, we have received neither the written confirmation nor an

Steele N. Gillaspey, Esq.
December 14, 2004
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amended notice of motion. We therefore request that you provide such written confirmation at your earliest convenience, and re-notice the motion by the end of this week, Friday, December 17.

Please contact me at your earliest convenience to discuss the foregoing issues.

Very truly yours,

A handwritten signature in black ink, appearing to be "John C. Rawls", written over the typed name.

John C. Rawls

Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: December 8, 2004

Opposition No. 92043766

APR NETWORK, INC.

v.

JUPITERMEDIA CORPORATION

Peter Cataldo, Interlocutory Attorney

Respondent's motion (filed November 18, 2004) to suspend the proceeding pending final determination of a civil action between the parties is hereby granted as well taken.¹ It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board case. See Trademark Rule 2.117(a).

Accordingly, proceedings are suspended pending final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate

¹ Respondent's answer to the petition for cancellation, filed concurrently therewith, is accepted and made of record.

action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

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